

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas L. CANTOR et al.

Application No.: 10/760,091

Filing Date: January 16, 2004

For: METHODS FOR DIFFERENTIATING
AND MONITORING PARATHYROID
AND BONE STATUS RELATED
DISEASES

Examiner: C. Cheu

Group Art Unit: 1641

Confirmation No.: 2110

**SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. § 1.97 & § 1.98**

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. §1.97 and § 1.98, Applicants submit for consideration in the above-identified application the documents listed on the attached Form PTO/SB/08a/b. Copies of the non-patent literature are submitted herewith. The Examiner is requested to consider and make these documents of record.

Document numbers 4-10 are from application number 10/956,760, also filed by the Applicants and now issued as U.S. Patent No. 7,465,703.

Document number 11 is from the reexamination of U.S. Patent No. 6,689,566, having Control numbers 90/007,685 and 90/007,732. The present application is a Continuation of U.S.

Patent No. 6,743,590, which is a Continuation-in-Part of U.S. Patent No. 6,689,566. Document number 2 is the Reexamination Certificate for U.S. Patent No. 6,689,566.

Document number 12 is from related application number 10/641,780. Document numbers 18, 25, 26, 30, 47, and 48 are from Patent Interference No. 105,575 (MPT), which involves related application number 10/641,780 and U.S. Patent No. 6,838,264.

Document numbers 13, 14, 38, 42, 54, and 55 are from related application number 10/945,608. Document numbers 37, 49, 56, 57, and 62 are from related application number 10/617,489. Document numbers 19, 34, 46, and 64 are from related application number 11/799,726. Document numbers 20 and 21 were cited by the examiner in document number 19. Document number 3 was cited in document number 64. Document numbers 27, 35, 36, and 50 are from related application number 11/894,367. Document numbers 1 and 51 were cited in document number 50.

Document number 15 is a Decision from an Opposition proceeding initiated by the Applicants against Japanese Patent No. 3457004. The patentee did not appeal to the Japanese Intellectual Property High Court and the patent expired on January 29, 2009.

Document numbers 16, 17, 28, 29, 32, 33, 60, and 61 are from *Scantibodies Laboratory, Inc. v. Immunotopics, Inc.*, at the United States District Court for the Central District of California, Case No. CV 04-08871 MRP (MANx), first appealed as Case No. 2008-1522 at the United States Court of Appeals for the Federal Circuit, currently appealed at the United States Court of Appeals for the Federal Circuit as Case No. 2009-1481. This litigation involves U.S. Patent No. 6,689,566. The present application is a Continuation of U.S. Patent No. 6,743,590, which is a Continuation-in-Part of U.S. Patent No. 6,689,566. Scantibodies Laboratory, Inc. is the assignee of the present application. Document number 16 is a Revised Order for Summary Judgment of Non-Infringement. Please note that information has been redacted from document number 60 on pages 6, 7, 8, 28, 29, 30, 44, and 46.

Document numbers 23 and 24 are from corresponding European application number 06008181.7. Document number 22 was cited in document number 24.

Document numbers 31, 43, 52, 53, 58, and 59 are from an Opposition proceeding against related EP Patent number 1 151 307. Document number 41 is from related EP application number 04786049.9.

Document numbers 39 and 40 are from application number 12/286,620. Applicants filed related application number 10/641,780 to provoke interference with application number 09/730,174. Application number 12/286,620 claims the benefit of application number 09/730,174.

Document number 44 is from Reexamination Control No. 90/007,412. Applicants are the Third Party Requestor in that matter. Document number 45 is from related Canadian patent application number 2,360,020. Document number 63 is from related Australian patent application number 2004266128.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☒ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under 37 C.F.R. § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
 - ☐ A fee is required. Accordingly, a Fee Transmittal Form (PTO/SB/17) is attached to this submission.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly, no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the Issue Fee.

☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal Form (PTO/SB/17) is attached to this submission.)

Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **532212000624**.

Dated: November 13, 2009

Respectfully submitted,

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